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To: Lynne G. Beresford

Company: Assistant Commissioner for Trademarks

Location: Arlington, VA

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Date: January 3, 1996

Remarks:

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January 3, 1996

Via Facsimile: (703) 308-7220

Assistant Commissioner for Trademarks
Attention of: Ms. Lynne G. Beresford
United States Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Communications With the Patent and Trademark Office

Dear Ms. Beresford:

This letter is to express on behalf of Minnesota Mining and Manufacturing Company ("3M") comments regarding proposed amendments to sections 1.1, 1.9, and 1.10 of 37 C.F.R. as published at 1180 O.G. 122 et seq. on November 28, 1995. The amendments affect communications with the Patent and Trademark Office ("PTO").

Addressing Correspondence

The proposed amendment to section 1.1 would provide for correspondence to the PTO to be addressed to one of the Commissioner of Patents and Trademarks, the Assistant Commissioner for Patents, or the Assistant Commissioner for Trademarks, depending upon the nature of the correspondence.

3M is strongly opposed to this proposed amendment, if correctly addressing correspondence is a necessary requirement to obtaining benefit of the filing date. Denial of a filing date of a piece of correspondence could result in a substantive loss of patent rights and/or incur substantial costs.

The proposed change would impose an undue burden on the public without providing any substantive benefit to the PTO.

It is not realistic or fair to expect the public to be familiar with the most current internal organization of the PTO so as to be able to distinguish between organizations reporting to the Assistant Commissioner for Patents and those reporting to the Commissioner of Patents and

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Trademarks. Any reorganization of the PTO might result in a change of applicable address requirements.

Under the proposed rule, an applicant filing a new application would be required to address the application to the Assistant Commissioner for Patents while a check for the filing fee must be made out to the Commissioner for Patents and Trademarks. Similarly, a request for reexamination of an issued patent would be required to be addressed to the Assistant Commissioner while an assignment of that patent would have to be addressed to the Commissioner. A request for an oral hearing is to be addressed to the Assistant Commissioner while communications with the Board are to be addressed to the Commissioner.

Denial of the benefit of a filing date for incorrectly addressing a piece of correspondence, i.e., a minor defect in form, when the substantive content of the correspondence complies with the rules would be an extreme and unwarranted sanction,

The change would present an administrative burden to applicants and practitioners who must maintain separate, but confusingly similar, stamps and word processing macros for preparing certificates of mailing and addressing correspondence.

Dyfar the major portion of incoming correspondence is handled by persons other than an Assistant Commissioner or the Commissioner. Thus, requiring selection of address between an Assistant Commissioner and the Commissioner would not facilitate sorting and handling of the correspondence.

For these reasons we oppose the proposed change to section 1.1*

Sorting and processing of incoming correspondence is best facilitated through use of Special Office Mail boxes as currently listed in each issue of the Official Gazette. Additional special boxes for other types of correspondence could be established to expand the benefits of the existing procedure.

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Federal Holidays Within District of Columbia

The proposed amendment to section 1.9 would define a federal holiday within the District of Columbia as including any day when the PTO is officially closed for a later announced reason such as adverse weather or other causes.

3M is opposed to this amendment to section 1.9, in view of the terms of section 1.10, either in its current form or if amended as proposed, regarding the date correspondence will be considered as filed in the PTO. The amendment to section 1.9 could lead to loss of valuable patent rights.

Many times an application is filed via Express Mail to secure a filing date in advance of a divulgence of the invention such as a product introduction at a trade show. An applicant will often file a patent application shortly before a divulgence event, intending to rely upon the filing date for subsequent foreign patent applications. Under the proposed amendment, an applicant following that procedure could find out that adverse weather led to closing of the PTO for the day on the day the application was filed, causing the filing date of the application to be changed to a later date. If that later date is subsequent to the divulgence, the applicant would lose valuable patent rights due to matters entirely beyond his control.

3M would support a more narrowly defined rule change that would permit any action or fee due to be taken or paid on the next succeeding day when the PTO is open. It is imperative, however, that such an amendment not prevent applicants filing in the United States from obtaining the earliest priority date to which they are entitled.

Express Mailing

It was proposed to amend section 1.10 to delete the requirement of a certificate of mailing and to incorporate requirements for resubmission of misplaced correspondence that parallel section 1.8.

3M strongly supports these amendments.

Entry of the "date in" notation by the postal service on the Express Mail envelope is adequate evidence of the date of mailing. The procedural requirement of a certification is

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thus unnecessary. Elimination of this requirement removes a potential technical error that can cost an applicant valuable rights.

Very truly yours,



Gary L. Griswold

GLG/RHJ/lhw

01/03/96

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A/C TM

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*****8***
*** ACTIVITY REPORT ***
*****8**

RECEPTION OK

TX/RX NO. 9240

CONNECTION TEL 612 733 9155

CONNECTION ID

START TIME 01/03 14:56

USAGE TIME 02'14

PAGES 5

RESULT OK